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OFFICE OF PETITIONS

In re Application of :
Sami Uskela et al. :
Application No. 09/405,088 :
Filed: September 27, 1999 :
Attorney Docket No. 017.37498X00 :

ON PETITION

This application has been referred to this office in view of the petition filed by facsimile transmission January 30, 2003, which while styled as a petition under 37 CFR 1.181 to withhold the holding of abandonment, concurrently requests suspension of "any requirement of the rules regarding abandonment," which is being treated by this office solely as a petition under 37 CFR 1.183 to waive the rules so as to avoid any holding of abandonment of the above-identified application.¹

The petition considered under 37 1.183 is dismissed. This is not a final agency action.

Petitioner asserts that he has been orally advised by the examiner that this application is considered abandoned due to applicants' failure to properly reply to the final office action of July 6, 2001. While a reply under 37 CFR 1.113 was filed on October 3, 2001, that reply did not *prima facie* place this application in condition for allowance, as indicated by the Advisory Action of October 22, 2001. A telephonic interview was conducted on November 7, 2001, and memorialized by the Interview

¹While petitions under 37 CFR 1.181 seeking review of an examiner's action or inaction in an application, including any holding of abandonment, are decided in the first instance by the appropriate Group Director, see MPEP 1002.02(c) ¶ 3, the Office of Petitions, and not Technology Center employees, has the delegated authority to waive any requirement of the rules which is not also a requirement of law. See MPEP 1002.02(b) ¶ 2.

Summary mailed November 9, 2001, to the correspondence address of record.

Petitioner complains that the examiner "failed to check the box [on the first Interview Summary Form] that no [further] response was required" and since this is apparently the reason this application has orally been held abandoned by the examiner, petitioner seeks waiver of the rules. Petitioner further points to a corrected version of the first interview summary mailed February 4, 2003, which now includes additional text in the last typed line to the effect that applicant was purportedly relieved of his obligation to reply to the outstanding Office action by the examiner, but notes that this text was omitted in the version mailed November 7, 2001.

A review of both of the Interview Summary Forms generated on November 7, 2001, and on February 4, 2003, fails to reveal the "box" to which applicant refers. That is, contrary to petitioner's urging, there is simply no "box" by which an examiner may indicate that an applicant is relieved of his obligation to reply to an outstanding Office action. Indeed, such a "box," if it did exist, would be inconsistent with, *inter alia*, 37 CFR 1.133(b) which provides in pertinent part:

An interview does not remove the necessity for reply to Office actions as specified in §§ 1.111 and 1.135.

Likewise, it is immaterial that the full text of the examiner's written account of the interview mailed November 9, 2001 did not contain the statement to the effect that applicant did not have to reply to the outstanding action. The examiners have not been delegated the authority by the Commissioner to waive the requirements of any rule, much less 37 CFR 1.133, and the USPTO itself certainly cannot avoid or overcome the operation of a self-executing statute like 35 USC 133. The "box" that is present on that form will only indicate, if checked, that "[i]t is not necessary for applicant to provide a separate record of the substance of the interview (if box is checked)."

Indeed, the form goes on to indicate in capital letters that if, as here, the "box" was not checked on November 7, 2001, and if, as here, a reply to the last Office action had already been filed, applicant had ONE MONTH to file a statement of the substance of the interview. A review of the record fails to reveal that applicant complied with this requirement.

Had applicant, as a prudent and careful person, timely reviewed the Interview Summary Form as mailed November 7, 2001, for its content, and, as such, any further obligation(s) on his part in this matter, petitioner might well have been able to avoid the very predicament in which he now finds himself. Indeed, applicant's first communication that bears at all on this issue appears to be a copy of a status request bearing the date of February 11, 2002, that was sent by facsimile transmission on January 28, 2003.

Initially, it is brought to applicants' attention that abandonment of an application occurs by operation of law for failure to reply. See e.g., 35 USC 133. That is, 35 USC 133 is a self-executing statute. If this (and it is not here determined) or any application is in fact abandoned, then the patent statute also provides a specific remedy for that condition--revival. See 35 USC §§ 41(a)(7), 111, 133, and 151. However, a standard principle of statutory construction is: *expressio unius est exclusio alterius* (the mention of one thing implies exclusion of another thing), namely absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other remedies for such situation. See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S. 282, 289 (1929) ("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode"). Since Congress has provided in Public Law 97-247 a specific scheme for the revival of abandoned applications (i.e., the specific situations under which the PTO may revive an abandoned application and the specific requirements (fee amounts and standards) applicable to each specific situation), the creation of other schemes such as a petition under 37 CFR 1.183 or 1.182 to obviate abandonment per se, or to create an alternate means of revival of any abandoned application would be inconsistent with the patent statute. Thus, the Commissioner's authority to revive an abandoned application is limited to that specified in the statutory scheme set forth in 35 U.S.C. §§ 41(a)(7), 111, 133, and 151. See Morganroth v. Ouigg, 885 F.2d 843, 847, 12 USPQ2d 1125, 1128 (Fed. Cir. 1989) (the Commissioner lacks the authority to revive an application abandoned by termination of court proceedings because 35 U.S.C. §§ 41(a)(7), 133, or 151 do not provide for the revival of an application abandoned in such a manner). If this application is in fact abandoned, it would not be appropriate to circumvent either the statutory provisions that automatically provide for abandonment of an application for

failure to reply, or the statutory provisions that provide for revival of an abandoned application, by way of a petition under 37 CFR 1.183.

To the extent that the USPTO has any discretion in this matter, in order for grant of any petition under 37 CFR 1.183, petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985). Petitioner has not shown that either condition exists in this case.

Equitable powers should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable, due care and diligence. U.S. v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983). In this instance, whether applicant presented a Notice of Appeal in view of the Advisory Action of October 22, 2001, or even timely replied to--or timely sought clarification of-- the Examiner's Interview Summary of November 7, 2001, was a circumstance entirely within his control. The Office, where it has the power to do so, should not relax the requirements of established practice in order to save an applicant from the consequence of his delay. See, Ex Parte Sassin, 1906 Dec. Comm'r. Pat. 205, 206 (Comm'r Pat. 1906) and compare Ziegler v. Baxter v. Natta, 159 USPQ 378, 379 (Comm'r Pat. 1968) and Williams v. The Five Platters, Inc., 510 F.2d 963, 184 USPQ 744 (CCPA 1975).

37 CFR 1.183 should not be considered a panacea for tactical errors in prosecution. See, Nitto Chem. Indus. Co. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (circumstances are not extraordinary, and do not require waiver of the rules, when a party makes an avoidable mistake in filing or not filing papers). Circumstances resulting from petitioner's, or petitioner's counsel's, failure to exercise due care, or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief. See, In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re Bird & Son, Inc. 195 USPQ 586, 588 (Comm'r Pats. 1977).

In any event, the USPTO will not normally consider an extraordinary remedy, when the rules already provide an avenue for obtaining the relief sought. See Cantello v. Rasmussen, 220 USPQ 664, 664 (Comm'r Pat. 1982). Petitioner has already invoked 37 CFR 1.181 for review of the holding of abandonment, and should

it prove necessary, 37 CFR 1.137 may be invoked by petitioner to seek revival.

The \$130 fee for a petition under 37 CFR 1.183 has been charged to deposit account No. 01-2135.

This application is being returned to Technology Center AU 3700 for consideration of the petition under 37 CFR 1.181.

Telephone inquiries related to this decision should be directed to the undersigned at (703) 305-1820.

A handwritten signature in cursive script, appearing to read "Brian Hearn".

Brian Hearn
Senior Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy